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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,156	10/17/2001	Adrianne Lewis	1248-R-01	5615

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/981,156

Applicant(s)

Lewis

Examiner
James W. Myhre

Art Unit
3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 17, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4&5 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 18-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 18-36 merely identify one or more types of data within a game (Claim 18), in a data signal (Claim 25), or as part of a template (Claim 32). Therefore, the Claims are considered to consist of entirely of non-functional descriptive material. This material does not create any functional interrelationships either as part of any stored data nor as part of the computing processes performed by a computer and does not impart functionality either to the data or to the computer. Such descriptive material is not a process, machine, manufacture, or composition of matter (*Warmerdam*, 33 F.3d at 1361 31 USPQ2d at 1760).

These rejection could be overcome by placing steps, similar to the steps in the method claims, within the claims. For example, the first two features in Claim 18 could be changed to read: (current preamble)....”presenting one or more advertising images to the one or more players; prompting the one or more players to access”... . Likewise, Claim 25 could be changed to read: “A computer data signal embodied in a transmission medium to execute an interactive advertising

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game on a computer network, wherein the computer data signal comprises one or more code segments which when executed on a computer causes the computer to perform the steps of: presenting one or more advertising images to one or more players; prompting the one or more players to access additional advertising material to play the interactive advertising game; and”... .

However, the Examiner notes that Claim 32 is merely claiming a data template used to present the game to the player. As such, there is no easy way to amend the claim (or its dependent claims) to provide functionality to a template and overcome the above rejection. Therefore, the Examiner recommends the Applicant cancel Claims 32-36.

In anticipation that the Applicant will amend the rejected claims to overcome the above rejection, the Examiner has addressed all of the claims in the rejection below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (5,916,024).

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Claims 1, 8, 13, 18, 25, and 32: Von Kohorn discloses a system, method, and computer program for advertising on a computer network, comprising:

- a. Incorporating one or more advertisements into an interactive game template;
- b. Presenting the interactive game to one or more players over the network; and
- c. Allowing the player to play the game based on the player's interaction with the advertisement (col 1, line 25 - col 10, line 43).

Claims 2, 9, 19, and 26: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the advertisement is an active element of the game (col 1, line 25 - col 10, line 43).

Claims 3, 10, 20, 27, and 34: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 26 and 32 above, and further discloses that the game is a trivia game and that the advertisement provides clues to the trivia questions (col 1, line 25 - col 10, line 43).

Claims 4, 11, 21, and 28: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 27 above, and further discloses prompting the player to access advertisements on the advertiser's website in order to progress in the game (col 1, line 25 - col 10, line 43).

Claims 5, 12, 22, 29, and 35: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 28, and 32 above, and further discloses providing one or more prizes to winning players (col 1, line 25 - col 10, line 43).

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Claims 6, 14, 15, 23, 30, and 36: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 13, 18, 29, and 32 above, and further discloses compiling demographic information on the player and targeting the advertisement based on the player's demographic information (col 1, line 25 - col 10, line 43).

Claims 7, 16, 24, 31, and 33: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 30, and 32 above, and further discloses that the game is one of a trivia game, bingo, dominoes, casino games, card games, tic-tac-toe, or jigsaw puzzle (col 1, line 25 - col 10, line 43).

Claim 17: Von Kohorn discloses a method for advertising on a computer network as in Claim 8 above, and further discloses placing the game into a computer advertising spot (col 1, line 25 - col 10, line 43).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Edwards et al (6,312,337) discloses a system and method for playing an online game incorporating a scavenger hunt for online photographic images.

B. Walker et al (6,443,843) discloses a system and method for playing an online game in which the player chooses a product from a group of advertisements as the prize for successfully completing the game.

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C. Simpson (US 2001/0049627) discloses a system and method for distributing electronic coupons using online games, such as trivia and arcade games.

D. Murata (US 2002/0013174) discloses a system and method for interactive advertising through online games.

E. Forден (US 2002/0022516) discloses a system and method for advertising inside electronic games.

F. Segan et al (US 2002/0029252) discloses a system and method for adapting an online characterization of a player based on his interaction with advertisements.

G. Ubale et al (US 2002/0042293) discloses a system and method for an interactive quiz game in which advertisement are inserted and may provide clues to the answer of the quiz questions.

H. Lesandrini et al (US 2002/0042733) discloses a system and method for conducting surveys and quizzes online in which the player must search online for the answers.

I. Remier (US 2002/0077906) discloses a system and method for cross-promoting products online by presenting advertisements for the related products while the user is interacting with the first product.

J. Graham et al (US 2002/0098891) discloses a system and method for providing an advertisement to a consumer by incorporating the advertisements into games.

K. Gould et al (US 2002/0120504) discloses a system and method for presenting a set of trivia questions associated with an advertisement to a user and rewarding correct answers.


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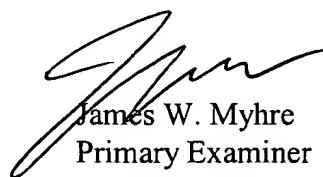
L. Adams et al (US 2003/0083943) discloses a system and method for awarding and redeeming promotional points associated with an electronic game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.


JWM
May 30, 2003


James W. Myhre
Primary Examiner
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